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IN THE

Supreme Court of the United States

OCTOBER TERM, 1939.

No. 102.

THE ATLANTIC REFINING COMPANY, *Petitioner*,

v.

JAMES B. BERRY SONS' COMPANY, INC., *Respondent*.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

At the threshold we would emphasize that the instant petition, filed May 25, 1940, seeks a review of exactly the same decision, or judgment, which this court refused to review when on January 2, 1940 it denied petitioner's first petition for a writ of certiorari, filed on November 22, 1939.

The decision, or judgment, in question was filed in the Circuit Court of Appeals for the Third Circuit on September 27, 1939, and affirmed the decree of the District Court for the Western District of Pennsylvania finding invalid patent 1,680,421, granted August 14, 1928 to petitioner as the assignee of J. W. Lewis, Jr.

The present petition, filed approximately eight months after the filing of the decision or judgment sought to be reviewed, merely urges an additional ground, in support of the relief sought, which petitioner elected not to suggest in its first petition.

No petition for rehearing was filed in the Circuit Court of Appeals pursuant to rule 27 of that court (224 F. xviii) but petitioner proceeded forthwith to file here its first petition aforesaid bottomed upon the ground that the Circuit Court of Appeals had applied a fallacious rule of law in affirming the decree of the District Court.

Manifestly for circumventing a charge of laches based on its failure to raise its present point in the Circuit Court of Appeals by petition for rehearing, or suggest it in its first petition filed in this court, petitioner presented in the Circuit Court of Appeals on January 27, 1940, a petition praying for the recall of the mandate, for the vacation of the decision of September 27, 1939, and for such further and other relief as the court might deem just.

The petition now at bar purports to be from the denial on February 28, 1940 of the last referred to petition, which the Circuit Court of Appeals termed a "petition for rehearing".

CHRONOLOGY OF FACTS.

We think it important that the Court should have before it the following chronology of facts in this case:

1. The bill of complaint which was filed on November 20, 1933 (R. 6) stated an ordinary patent infringement case.

2. The decree of the District Court finding the patent declared upon invalid and dismissing the bill with costs was filed May 4, 1936 (R. 635).

3. An appeal having been prosecuted to the United States Circuit Court of Appeals for the Third Circuit, the case was argued before said court constituted of Judge Buffington and Judge Biggs, Circuit Judges, and Judge Dickinson,

District Judge. It was taken under advisement (R. 660a), and thereafter a decision was rendered (R. 660b-660g) which is found in the final paragraph of an opinion by Judge Buffington and which reads as follows (R. 660g):

> "It follows, therefore, the record must be remanded to the court with instructions to reinstate the bill, enter a decree of infringement and accounting."

The transcript does not show an order on said decision.

4. A petition for rehearing was filed (R. 660h-660t), and was granted on April 6, 1938 (R. 660u).

5. The case was reargued on May 3, 1938 before the judges who constituted the court upon the original argument (R. 660u), was taken under advisement, and thereafter a decision was rendered (R. 660v) which is found in the final paragraph of an opinion written by Judge Biggs, and reads as follows (R. 660dd):

> "As stated in our prior opinion the decree of the court below is reversed and the cause is remanded to the court below with instructions to reinstate the bill of complaint and enter a decree of infringement and for an accounting."

6. An order on said decision, signed by Judge Biggs alone, was filed December 21, 1938 (R. 660dd).

7. A petition for second rehearing was thereupon filed (R. 660ee-660ll).

8. An order granting said petition was filed in the case April 20, 1939 (R. 660mm).

9. The case was called May 10, 1939 for a second reargument before the same judges who heard the previous arguments. The record contains a memorandum reading (R. 660mm):

> "And afterwards, to wit, on the 27th day of September, 1939, come the parties aforesaid by their coun-

sel aforesaid, and the Court, now being fully advised in the premises, renders the following decision:".

Thereupon follows an opinion by Judge Biggs, concluding with the following (R. 660yy):

> "We therefore reverse our former conclusions and hold that the claims sub judice are invalid for want of invention.
>
> "Accordingly, the decree of the court below is affirmed.
>
> "*Judge Dickinson participated in this decision."

A "dissenting opinion" by Judge Buffington (R. 660eee-660kkk) states, *inter alia*, as follows (R. 660iii):

> "Subsequently another rehearing was granted, the case again heard and considered, with the result that an opinion is now filed which holds the patent void of patentability."

10. On September 27, 1939 there was duly filed an order by the court signed by Judge Biggs, *Circuit Judge*, adjudging and decreeing that the decree of the *District Court* be affirmed with costs (R. 660lll).

11. On November 22, 1939, petitioner filed in this Court a petition praying in the *first* paragraph thereof "that a writ of certiorari issue to the United States Circuit Court of Appeals for the Third Circuit to review a *decision*[1] of that court entered September 27, 1939 (R. 660nn)". The petition concluded as follows:

> "Wherefore, it is respectfully submitted that this petition for writ of certiorari to review the *judgment* of the Circuit Court of Appeals for the Third Circuit should be granted."

12. This petition was denied on January 2, 1940.

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[1] Where italics are used in quotations, it will be understood that the emphasis is ours unless otherwise noted.

13. A mandate thereupon issued out of the Circuit Court of Appeals on January 8, 1940 (R. 660mmm).

14. On January 27, 1940, long after the expiration of the period for filing a petition for rehearing in the Circuit Court of Appeals, and on the very day that the time expired for filing a petition for rehearing in this Court of its denial of the petition for certiorari, petitioner filed in the Circuit Court of Appeals for the Third Circuit a petition for

> "the vacation of the purported decision and decree of this court filed herein September 27, 1939, for the recall of the purported mandate issued herein by the clerk of this court January 8, 1940, and for such other and further relief as this court shall deem to be just" (R. 660nnn).

This petition was based on the fact that Judge Dickinson had died before the written decision and the order thereon, or judgment, was filed, and that Judge Buffington had written a dissenting opinion.

15. On February 28, 1940, a per curiam memorandum was filed reading as follows (R. 660rrr):

> "The order entered in this cause upon September 27, 1939 was the order of this court since Judge Buffington joined in authorizing its entry.
> "Accordingly the *petition for rehearing* is denied."

16. On the same day there was received and filed an order signed by Circuit Judges Biggs and Buffington denying the *petition for rehearing* (R. 660sss).

ARGUMENT.

As a preliminary to a discussion of the ground upon which the instant petition for certiorari is based, we would call attention to the fact that in respondent's brief in opposition to the first petition for certiorari it was pointed out that the petition (and the same applies to the instant one) was peculiarly without merit because:

(a) The suit was an ordinary patent suit involving the usual questions of validity and infringement. There was no conflict of decision between Circuit Courts of Appeals or, for that matter, between any other courts. No novel questions of patent law were involved.

(b) The suit was the outgrowth of a patent pooling confederacy involving upward of 130 patents, relating to the distillation of petroleum, owned or controlled by a few financially powerful companies seeking to exact tribute from all petroleum refiners and manufacturers of refinery equipment outside of the confederacy.

(c) The plan led to an agreement to suppress evidence relative to the scope and validity of the pooled patents.

(d) The Lewis scheme involved only the addition of an open steam stripper—an admitted tool of the distilling industry—to a *side* stream of an old type of petroleum distilling unit comprising a pipe heater and a rectifying column having side and bottom stream draw-off lines and with open steam stripping of the *bottom* stream. The stripper in both locations does the same work; it effects the removal, by vaporization, of low boiling components from the streams en route to storage. At best it was a mere carrying forward, or more extended application, of an old device and therefore not patentable. *Smith* v. *Nichols*, 21 Wall. 112.

It was also pointed out that if the scheme of the patent in suit is not completely anticipated by *each* of a number of prior art patents, nevertheless it does not exhibit patentable invention for the reasons stated by this court in *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U. S. 350, and in the cases there cited.

The present petition advances no meritorious ground for disturbing the decision of the Circuit Court of Appeals affirming the decree of the District Court, but makes a most attenuated technical contention only by which peti-

tioner seeks to advantage itself by the death of Judge Dickinson.

In addition to the grounds which were presented in opposition to the allowance of the original petition for writ of certiorari, it is submitted that the instant one should be denied for each of the reasons which follow:

POINT I.

The instant petition seeks exactly the same relief as the previous one denied by this Court, i. e., the vacation of the judgment of the Circuit Court of Appeals of Sept. 27, 1939, the only difference being in the grounds relied upon. Hence the instant petition is not timely filed.

As stated at the beginning of this brief, the instant petition, while *specifically* addressed to an order entered by the Circuit Court of Appeals on February 28, 1940 which denied the petition to that Court (filed subsequent to the denial by this Court of the first petition for certiorari) to vacate its judgment of September 27, 1939, in reality and in substance is a petition to review the legality of such judgment and to have the same ultimately vacated by this Court. Exactly the same purpose was sought to be accomplished by the first petition aforesaid. As the record shows, the facts upon which the instant petition is bottomed existed at the time of the filing of the first petition. Petitioner, by addressing the present petition to the order of the Circuit Court of Appeals entered on February 28, 1940, is thus clearly attempting to circumvent and escape the bar of the statute which prescribes that no appeal, or writ of certiorari, shall be allowed or entertained unless application therefor be made within three months after the entry of the "judgment or decree" sought to be brought before this court for review (28 U. S. C. Sec. 350).

If petitioner can avoid the bar of this statute by the device it adopted of filing a petition in the Circuit Court of

Appeals after this Court had denied its petition for a writ of certiorari, basing the former upon a different ground, or a different view of the facts exhibited by the record presented to this Court upon its first petition, then any unsuccessful litigant in a Circuit Court of Appeals could postpone the application of such statutory bar for a period measured only by his ability, or ingenuity, in framing additional criticisms of the "judgment or decree". To state this proposition, we submit, is to expose its sophistry and demonstrate that the present petition cannot be entertained.

It is, of course, a well settled rule that questions which were available and might have been, but were not, raised or presented on a prior appeal or writ of error, will not be considered on a subsequent one. A vast number of cases supporting this rule are collected in 1 American Law Reports, 725. It will be suffifficient here to call attention to only the following: *Illinois* v. *Illinois Central R. Co.*, 184 U. S. 77, 92-93; *Sorensen* v. *Pyrate Corporation*, 65 F. (2d) 982, where the Federal authorities are collected and discussed; *Raydure* v. *Lindley*, 268 Fed. 338, 341 (C. C. A. 6th); *Burns* v. *Cooper*, 153 Fed. 148, 151 (C. C. A. 8th); *Guaranty Trust Co.* v. *International Steam Pump Co.*, 242 Fed. 920, 921; *The Santa Maria*, 10 Wheat. 431, 433.

In the light of this general rule, as well as the familiar rule that a judgment is *res adjudicata* not only of the questions litigated in the case but of any questions that might have been litigated, and in view of the facts and considerations above referred to, it must follow, we submit, that the present petition is barred by the statute. As a question which might have been litigated in a former phase of the same suit, or in another suit between the same parties, but which was not so litigated, cannot thereafter be considered on a subsequent appeal in the same suit or in another suit between the same parties, *a fortiori* a question which might have been but which was not presented in a petition for a writ of certiorari filed within three months from the date of the entry of the judgment or de-

cree sought to be reviewed, cannot be asserted *after the expiration of such three months* as a means for attacking the same judgment through the exercise of any expedient.

If, by any chance, the instant petition might be considered as a petition for rehearing of the denial of the first petition (which it does not even purport to be), it could not be entertained because it was filed long after the 25 days allowed by Rule 33 of this Court for filing petitions for rehearing had expired.

Under the caption "Jurisdiction" in petitioner's brief, three cases are cited, presumably in support of petitioner's right to file a petition for certiorari to review "an order ruling upon an application for the vacating of a decree". These cases seem to us to be utterly irrelevant to the question as to whether this Court should grant a certiorari under circumstances present in this case. Indeed, two of the cases were before the Court on a writ of error and the third on a certificate from the Court of Appeals of the District of Columbia. For the convenience of the Court, if it desires to examine these cases, we have inserted a brief digest of them in an appendix.

POINT II.

The decision and judgment of September 27, 1939, were entirely valid and within the power of the Circuit Court of Appeals to render and enter.

It is clear that the decision of the court had been reached prior to the death of Judge Dickinson. The opinion announcing the decision was not entered until a few days after his death. The judgment was entered concurrently with the filing of the opinion and was the joint action of Judges Biggs and Buffington, who also signed the order of February 28, 1940, denying the petition for rehearing (R. 660rrr, 660sss). The statute creating Circuit Courts of Appeals (28 U. S. C. § 212) is as follows:

> "There shall be in each circuit a circuit court of appeals, which shall consist of three judges, *of whom two shall constitute a quorum*, which shall be a court of record, with appellate jurisdiction, as hereinafter limited and established."

As two judges constitute a quorum, Judge Biggs and Judge Buffington had the power to enter the judgment of September 27, 1939, even though Judge Dickinson had died prior thereto. The order merely carried out the decision which had been reached in the case by the court prior to Judge Dickinson's death. It was a ministerial act giving effect to the court's decision. It does not follow, of course, that because Judge Buffington dissented from the decision, he thereby became disqualified as a member of the Court so that the Court could not enter an order making its own decision effective. *The decisive point is that the decision had been reached by the Court before Judge Dickinson's death.* The distinction between such a case and one where a decision *has not been reached before the death of one judge* and where the remaining two judges are in disagreement, is made apparent in *James* v. *Clements*, 217 Fed. 51 (C. C. A. 5th) where it was said:

> "*Before reaching a final conclusion* the death of Judge Shelby, who constituted a part of the court in the case, supervened, leaving only two judges to determine the matter, *and they not fully concurring* on certion points necessarily arising under the assignments of error.
>
> "*Under these circumstances* and that justice may be done, we feel compelled to grant the rehearing asked and order the case restored to the docket for reassignment and submission before a full bench."

This language carries the clear implication that if the Court had reached a "final conclusion" before the death of Judge Shelby, the decision would have been given effect.

Petitioner, in seeking to give a *decisive* position to the ministerial act of entering a judgment on a decision pre-

viously reached by an appellate court, completely overlooks that the judgment merely records a decision of the Court. Although that decision could, of course, be changed at any time prior to the entry of the order thereon and, indeed, thereafter, the fact is that *it was not changed* in the case at bar.

As a decision had been reached before Judge Dickinson's death, it would seem that the principle upon which this Court decided *Life & Fire Insurance Co. of New York* v. *The Heirs of Nicholas Wilson,* 33 U. S. 291, applies. There the judge who tried the cause died before the signing of the judgment, and this Court directed that a writ of mandamus be issued directing his successor to sign the judgment.

In the complete absence of a suggestion of fraud, it is submitted that this Court should not look behind these proceedings, which are not only fair and regular upon their face, but were accepted as such *by petitioner* in filing the original petition in this Court for a writ of certiorari.

POINT III.

Even were the decision and judgment of September 27, 1939, nugatory the present petition nevertheless should be denied.

On April 20, 1939, the court entered the following order (R. 660mm):

> "And now, to wit, April 20, 1939, after due consideration, the petition for second rehearing in the above entitled case is hereby granted."

The effect of that order was to vacate all previous orders of the Circuit Court of Appeals.

In *Hook* v. *Mercantile Trust Co.,* 95 Fed. 41 (l. c. 49), Judge Woods, speaking for the Circuit Court of Appeals for the Seventh Circuit, said:

> "It is further contended that the judgment of this court rendered upon its first opinion was not vacated by the granting of a rehearing, and that, the judgment so rendered being still in force the motion to dismiss came too late. The petition of the appellees for a rehearing challenged the opinion of the court in its entire scope, and, as already explained, was granted for reasons equally comprehensive. *The intention of this court is that the granting of a rehearing without restriction shall operate to vacate its judgment, so that thereafter the cause shall stand as if no judgment had been entered.*"

To the same effect is *United States* v. *Bentley & Sons Co.*, 293 Fed. 229 (l. c. 237) (District Court, S. D. Ohio), where Judge Sater said:

> "A rehearing is simply a new hearing and a new consideration of the case on the same record. * * * *If granted, the attitude of the case is the same as if it had not previously been submitted.* * * * But when a judgment is opened up and the party obtaining the rehearing is again defeated and the previous judgment is affirmed, the original judgment is restored in full force and finally concludes all rights in the premises."

If the instant case, the Circuit Court of Appeals evidently so considered the order of April 20, 1939. This deduction follows from the fact that the order of September 27, 1939, is as follows (R. 660lll):

> "This cause came on to be heard on the transcript of record from the District Court of the United States, for the Western District of Pennsylvania, and was argued by counsel.
>
> "On consideration whereof, it is now here ordered, adjudged, and decreed by this Court that the *decree of the said District Court* in this cause be, and the same is *hereby affirmed,* with costs."

It will be noted that this order does not *vacate* that of December 21, 1938, but simply *affirms* the order of the District

Court. At the conclusion of Judge Biggs' opinion he states (R. 660yy):

"We therefore reverse our former *conclusions* * * *."

Thus if, as contended by petitioner at bar, the legal effect of the equal division of the surviving members of the Circuit Court of Appeals on the second rehearing was to affirm the prior decision, it would be the decree of the District Court which would be affirmed, since all previous decisions of the Circuit Court of Appeals were vacated by the allowance of the petition for rehearing on April 20, 1939.

CONCLUSION.

In our view of the case, the various decisions cited under the caption "Argument" in petitioner's brief are so unrelated to the real questions at bar that we deem it unnecessary to discuss them.

It is respectfully submitted that the petition should be denied.

Respectfully submitted,

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